

### REMARKS

Applicants have amended claim 1 to more particularly point out and distinctly claim the subject matter which they regard as their invention. Support for this limitation can be found in the specification at page 6, lines 33-38. Applicants have also amended claim 12 to correct a typographical error. No new matter has been introduced by the amendments.

Claims 1-20 are now pending. Applicants request that the Examiner reconsider this application, as amended, in view of the following remarks.

#### Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejects claims 1-20 for indefiniteness on the ground that, in independent claim 1, the language “at least polyisocyanate” is unclear and the phrase “the prepolymer” lacks antecedent basis. Applicants have rectified both deficiencies.

#### Rejections under 35 U.S.C. § 102(e)

The Examiner maintains the rejection of claims 1-13 and 16-19 for anticipation, asserting that the invention covered by these claims is described in Lamers et al., U.S. Patent Application Publication 2002/0114955 (Lamers). Lamers, cited under 35 U.S.C. § 102(e), has an earlier filing date than the present application.

In their response to the first office action, Applicants submitted a declaration by inventor Paul Lamers under 37 CFR 1.132, stating that the subject matter described in Lamers and relied upon by the Examiner is the work of the three inventors named in the present application, i.e., Hans-Dieter Hille, Karsten Jahny, and Paul Lamers. Applicants submitted that, based on the stated fact, Lamers does not constitute a 102(e) reference.

The Examiner, however, asserts that the declaration “has failed to establish Paul Lamers as the sole inventor of the relied upon subject matter.” See the Office Action, page 7, lines 16-17; emphasis added. He proceeds to conclude that “[a]s a result[,] the declaration fails to establish that this [relied-upon subject matter] was not an invention by ‘another.’” See the Office Action, page 7, lines 17-18.

Applicants disagree. To establish that the relied-upon subject matter was not invented by another, it is not necessary that Paul Lamers, the only common inventor named in both applications, is the sole inventor of the subject matter at issue. Indeed, all one needs to show is that the subject matter is the work of the inventors named in the present application. As stated in the declaration, the three named inventors, Hans-Dieter Hille, Karsten Jahny, and Paul Lamers, invented the relied-upon subject matter, which is described but not claimed in Lamers. See paragraph 4. This fact compels the conclusion that the subject matter was not invented by "another."

Clearly, the Examiner errs in requiring that Paul Lamers be the sole inventor of the subject matter disclosed in Lamers and relied upon by the Examiner. Indeed, "a 35 USC. 102(e) rejection can be overcome [] by submitting an affidavit or declaration under 37 CFR 1.132 establishing that the relevant disclosure is applicant's own work." See the Manual of Patent Examination Procedure § 2136.05 (emphasis added; here the three applicants'/inventors' own work). As the declaration has established that "the relevant disclosure is [Applicants'] own work," it is respectfully submitted that this 102(e) rejection has been overcome.

#### Rejections under 35 U.S.C. § 103 (a)

The Examiner rejects claims 14, 15, and 20 for obviousness relying on Lamers in view of Vandevoorde et al., U.S. Patent 6,429,256 (Vandevoorde).

Claims 14, 15, and 20 all depend from claim 1. Like claim 1, they cover a water-thinnable polyurethane prepared by first reacting an alkanolamine with a NCO compound and then reacting the resulting alcohol intermediate with a cyclic carboxylic anhydride, in which the NCO compound is obtained by reacting polyisocyanate with saturated polyester polyol or polyether polyol. As a result of the just-mentioned reactions, the polyurethane includes at least three functional groups: (1) carbamate resulting from the reaction between polyisocyanate and polyol, (2) urea resulting from the reaction between the alkanolamine and the NCO compound, and (3) ester resulting from the reaction between the alcohol intermediate and the cyclic carboxylic anhydride.

As discussed above, Lamers does not constitute a 102(e) reference. Indeed, it does not qualify as prior art under any section of 35 U.S.C. § 102. As such, it also does not qualify as prior art under 35 U.S.C. § 103. Thus, this reference should be removed.

Vandervoodre, the remaining reference, discloses a composition containing (1) a polyol having a carboxylate or carboxylic moiety and a sulfonate or sulfonic acid moiety, and (2) a cross-linking agent reactive to hydroxy groups. It does not teach or even suggest a polyurethane having all of the three functional groups, i.e., carbamate, urea, and ester, as required by claims 14, 15, and 20. Thus, with removal of Lamers, Vandervoodre alone does not render claims 14, 15, and 20 obvious.

For the reasons set forth above, Applicants respectfully request that this rejection be withdrawn.

#### CONCLUSION

Applicants submit that the grounds for the objections and rejections asserted by the Examiner have been overcome and claims 1-20 cover subject matter that is novel and unobvious over the prior art. Applicants request that all pending claims be allowed.

Please apply any charges to Deposit Account No. 50-4189, referencing Attorney Docket No. 60016-004US1.

Respectfully submitted,

Date: 8-29-07

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